

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 1-27 will be pending, claims 1, 19, and 22 being independent.

Summary of the Office Action

The specification is objected to with regard to the phrase in paragraph 0021, "the upper edge of the upper," which should be changed to "the upper edge of the liner."

Claims 1-11 are rejected under 35 USC §112, second paragraph, as being indefinite.

Claims 1, 2, and 5 are rejected under 35 USC §103(a) as being unpatentable over ABEL (U.S. Patent No. 3,289,328) in view of CAPLAN (U.S. Patent No. 2,003,105).

Claims 1-5, 10, and 11 are rejected under 35 USC §103(a) as being unpatentable over DELGORGUE et al. (U.S. Patent Application Publication No. 2002/0139008, hereafter "DELGORGUE") in view of ABEL and CAPLAN.

Claims 6-9 are rejected under 35 USC §103(a) as being unpatentable over DELGORGUE in view of ABEL, CAPLAN, and JOHNSON (U.S. Design Patent No. 470,647).

Response to the Office Action

A. Summary of the Amendment

1. Specification

Various paragraphs of the specification have been amended for "cosmetic" reasons, thereby improving readability.

In addition, certain paragraphs have been amended to provide proper antecedent bases for expressions used in the claims. Certain of the amendments find support at least

in the drawings, such as the sentence added at the end of paragraphs 0015 and 0018. No prohibited new matter has been added.

2. Claims

Independent claim 1 has been amended in response to the indefiniteness rejection and to improve its form. In particular, the end of the claim has been amended to specify that the first and second seams are the only seams for assembling the *liner together* and not for assembling the upper to the bottom assembly.

In addition, claim 1 has been amended to change “vertical assembly seam” to “vertical or substantially vertical assembly seam.” Support for this amendment can be found in paragraph 0016 of the originally filed application.

Dependent claim 6 has been amended merely for a cosmetic reason (i.e., “fine mesh” for “fine-meshed”). New claims 12-27 have been added, claims 19 and 22 being independent.

B. Request for Withdrawal of Objection to Paragraph 0021

In view of the amendment made to paragraph 0021 of the specification of the instant application, consistent with the Examiner’s instruction, Applicant kindly requests withdrawal of the objection.

C. Request for Withdrawal of Indefiniteness Rejection

In view of the amendment to claim 1 above, reconsideration and withdrawal of rejection indefiniteness is kindly requested.

Applicant acknowledges, with gratitude, the Examiner’s indication of her understanding of the invention (as explained in the rejection), in spite of the inadvertent wording in claim 1. Indeed, in the amendment, Applicant has corrected the final limitation to refer to the first and second seams being the only seams for assembling the liner together.

D. Request for Withdrawal of Rejection Based upon ABEL and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of ABEL and CAPLAN, are kindly requested.

According to Applicant's invention, the liner of the invention is assembled together **only** by means of first and second assembly seams, such seams being on the **lateral side** of the upper of the article of footwear. Neither ABEL nor CAPLAN teach or suggest this limitation and, accordingly, reconsideration and withdrawal of the invention is kindly requested.

According to the invention, any discomfort that might be felt by the wearer of a shoe or boot according to the invention can be alleviated by keeping the seams or stitchings on the lateral side. This has not been recognized by ABEL and CAPLAN. By contrast, in column 2, lines 26-32, ABEL explains that, for a sock for the left foot, the seams would be on the right side of the foot, i.e., the **medial side**.

In addition, the rejection relies upon the "sole wall 6" of ABEL's sport sock as corresponding to Applicant's claimed "bottom assembly." However, as evidenced by ABEL's specification (see column 1, lines 55-57), the sole wall 6 of ABEL is part of his liner. Applicant's recited "bottom assembly" is separate from the upper, i.e., separate from the liner."

Still, with regard to this last point, Applicant has added new claims 15-18 to further recite this distinction. For example, new claim 15 specifies that the bottom assembly comprises an outer sole. In claim 16, the liner is specified as being an integral part of the article of footwear, fixed against removal for wear separate from the article of footwear. New claim 17 specifies that the liner is stitched in placed as an integral part of the article of footwear. New claim 18 specifies that the liner is a slipper including vamp and a sole.

By placing the assembly seams of the liner on the lateral side of the article of footwear (in contrast with the medial side thereof), Applicant has discovered that the foot is

less injured by repeated rubbing of the foot against the seams, as explained in the specification. For example, during running, the part of the foot that is most stressed is the one going from the lateral side of the heel to front part of the medial side, which corresponds to the oblique unrolling of the foot.

Reconsideration and withdrawal of the rejection is kindly requested.

E. Request for Withdrawal of Rejection Based upon DELGORGUE, ABEL, and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of DELGORGUE, in view of ABEL and CAPLAN, are kindly requested.

DELGORGUE discloses an article of footwear having an upper, bottom assembly, and a "liner" (upper 11, according to the examiner; actually element 10 is the upper, element 11 being the opening of the upper). Not mentioned by the examiner is that *in addition to the upper/"liner" 11*, DELGORGUE has a liner 40 (see Fig. 2) to be inserted into the upper/"liner" 11.

The examiner's position is that it would have been obvious to have substituted ABEL's sport sock in place of the "liner" 11 of DELGORGUE. Although there might be a superficial similarity between DELGORGUE's exploded diagram of Fig. 1 and Applicant's exploded diagram of Fig. 2 of the instant application. However, Applicant submits that it would be incorrect to characterize element 10 (or 11) of DELGORGUE a "liner," inasmuch as it is said to be made of leather or a coated fabric and has a sole made of PVC (see paragraph 0018 of DELGORGUE). That is, to replace a leather upper with a sport sock like that of ABEL (made of "terry stretch cloth", e.g., as mentioned in column 2, lines 12-13) would not have been done by a person skilled in the art. Structural integrity of the upper would be completely sacrificed, inappropriate, and the objectives of DELGORGUE would not be met. Terry stretch cloth, or similar

material, would not be impervious as identified by DELGORGUE (see paragraph 0018) as characterizing his upper 10.

Reconsideration and withdrawal of the rejection is kindly requested.

F. Request for Withdrawal of Rejection Based upon DELGORGUE, ABEL, CAPLAN, and JOHNSON

Reconsideration and withdrawal of the rejection, based upon the combination of DELGORGUE, ABEL, CAPLAN, and JOHNSON are kindly requested.

The purpose of this ground of rejection is to address the limitation in claims 6-9 directed to the "outer protective layer" for the upper (see element 33, e.g., in Applicant's Fig. 2), which is placed over the front of the liner 40.

In this rejection, the Examiner additionally relies upon the design patent to JOHNSON, which illustrates (but does not meaningfully describe) a "shoe cover."

The logic of the rejection, in concluding that a person of ordinary skill in the art would create your invention with the combination of DELGORGUE, ABEL, CAPLAN, and JOHNSON, would appear to be the following. First, DELGORGUE's boot would be dismantled to remove the leather and PVC impervious upper 10 and replace it with a terry cloth sock of ABEL. Then, because the upper would be so fragile, it would be necessary to add a "shoe cover" as shown by JOHNSON "for shielding shoes from scratches and abrasions" (i.e., the final line of Section 8 of the Office action). Of course, if DELGORGUE's leather and PVC upper were not replaced, one skilled in the art would have no need for JOHNSON's shoe cover.

Reconsideration and withdrawal of the rejection is kindly requested.

G. New Claims

As mentioned above, new claims 12-27 have been added. Of these, claims 19 and 22 are independent.

In contrast to ABEL's sock, e.g., claim 19 calls for the article of footwear according to the invention to include a bottom assembly that includes an outer sole, as well as a liner that includes both a vamp and a sole fixed with regard to other parts of the article of footwear against withdrawal from the article of footwear.

Also, as seen in Applicant's FIG. 2, new claim 19 specifies that the vamp and sole of the liner are made in one piece along a first predetermined length of the periphery of the sole of the liner located ***only on a medial side*** of the article of footwear, whereas ***on a lateral side*** of the article of footwear along a second predetermined length of the periphery of the sole of the liner, the sole of the liner and the vamp are stitched at a first assembly seam. The claim also calls for a second assembly seam comprising an upwardly extending stitching also ***on the lateral side*** of the article of footwear. In addition, claim 19 specifies that the liner is assembled together ***only by means of the first and second assembly seams***.

This combination of limitations is not taught or suggested by the references relied upon.

Dependent claim 20 specifies that the tightening system of claim 19 comprises a lacing system.

Dependent claim 21, further specifies that the liner further comprises an elongated opening in an area of the article of footwear for passage of a foot of a wearer of the article of footwear, such area corresponding to a top of the foot of the wearer, and wherein the tightening system include laces extending in a lacing pattern over the elongated opening.

In addition to independent claim 19, Applicant has presented independent claim 22, which is directed to an article of footwear that includes both an extensible, ventilated material at the front section of the upper (as mentioned in paragraph 0024 of the

specification), as well as an outer protective covering layer (such as layer 33 mentioned in paragraph 0026), which comprises a mesh material.

Dependent claim 23 calls for the front section of the upper to extend from a front end at least through an area of the upper for passage of the foot of the wearer of the article of footwear, such area corresponding to a top of the wearer's foot.

Dependent claim 24 specifies that the outer protective cover layer is made of a nondeformable material, claim 25 further specifying that such material is NYLON.

Dependent claim 26 adds a limitation in the form of a reinforcing gusset (see, e.g., element 31 in Fig. 2, and paragraphs 0021-0022 of the specification) assembled to the upper in a heel zone, the gusset extending forwardly on lateral and medial sides of the article of footwear **toward** the outer protective covering layer.

Dependent claim 27 further specifies that the reinforcing gusset is assembled to the upper in a heel zone, with gusset extending forwardly on lateral and medial sides of the article of footwear **to** the outer protective covering layer, as specified in paragraph 0027 of the specification.

SUMMARY AND CONCLUSION

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is attached which includes a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no request for extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests such extension of time so as to render this reply

- timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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